

REMARKS

Appreciation is hereby expressed to Examiner Kassa for the interview so courteously and professionally conducted herein on March 9, 2011. In accordance with same, claim 1 has been amended to more definitely set forth the invention and obviate the rejections. Support for the amendment of Claim 1 can be found in the Specification on page 27, lines 1-13. In addition, new claim 17 has been presented. Support for the subject matter of new claim 17 can be found in the Specification on page 31, first paragraph. The present amendment is deemed not to add new matter. Claims 1, 4 and 17 are now in the application.

Reconsideration is respectfully requested of the denial of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

In particular, attached hereto is a certified English translation of the Japanese Application No. 2004-042231, the priority application claimed herein. In view of the presentation of same, and the correspondence thereof to the present application, it is believed that the applicant is now entitled to the priority date of same. The granting of the foreign priority date of JP 2004-042231 is accordingly respectfully requested.

Reconsideration is respectfully requested of the objection to the Specification. As shown above, the Specification has been amended herein to now include reference to the prior foreign and PCT applications upon which the present U.S. application is based, and upon which priority is claimed herein. In view of these amendments, it is believed that the objection is now moot. Withdrawal of the objection is accordingly respectfully requested.

Reconsideration is respectfully requested of the rejection of claims 1 and 4 under 35 U.S.C. 103(a) as being unpatentable over Ferrari, et al., Tanaka (as filed in an IDS herein), Nakamura, et al. and Simon.

The Examiner's primary reference of Ferrari, et al. discloses a cosmetic composition comprising a liquid lipid phase containing silicone oil and zinc particles. However, as the Examiner has correctly recognized, Ferrari, et al. fail to disclose or suggest the hydrophobic zinc powder claimed herein. In addition, Ferrari, et al. fail to disclose or suggest the specific claimed caprylylmethicone, particularly within the now claimed specific weight ratio, as well as the claimed organic modified clay material of claim 4.

To cure these deficiencies, the Examiner has cited Tanaka, Simon and Nakamura, et al. Tanaka merely discloses hydrophobically treating the zinc oxide powder, but also fails to disclose the caprylylmethicone in the claimed range herein, as well as the organic modified claim material claimed herein. Simon, although disclosing caprylylmethicone (see column 7, Example 3), fails to disclose the combination of same with hydrophobic zinc oxide powder and 0.5-4 wt% of a polyoxyalkylene-modified organopolysiloxane (i.e., the lipophilic active material).

Further, as discussed with Examiner Kassa during the interview, it is understood that the Examiner has applied the Nakamura, et al. reference as a 102(e)/103 reference. As such, it is strongly urged that Nakamura, et al. does not qualify as prior art under 35 U.S.C. 103(c), as the Nakamura, et al. reference and the claimed invention herein were, at the time the claimed invention was made, subject to an obligation of assignment to the same assignee. In particular, both the Nakamura, et al. reference and the instant application are both assigned to Shiseido Company, Ltd.,

and were subject to assignment to same at the time the present invention was made. As evidence of same, attached hereto is a copy of the Assignment filed in the instant application.

In view of the disqualification of Nakamura, et al. as a prior art reference herein, in addition to the above mentioned deficiencies, the combination of references cited by the Examiner further fail to disclose or suggest the organic modified claim material, i.e., hectorite as elected herein. The claimed organic modified clay material increases the stability of the cosmetic, improves the ease with which it spreads when applied, and gives the cosmetic a fresh sensation when used. The organic modified clay material is further blended in the invention as an emulsion aid.

Adding a (d) lipophilic active material to the sunscreen cosmetic of the present invention results in a water-in-oil emulsified sunscreen cosmetic that spreads easily, and has a fresh sensation when applied to the skin. In addition, it was unexpectedly discovered that by combining (a) the claimed hydrophobic zinc oxide powder (b) a volatile silicone, (c) 1-10 wt% caprylylmethicone, and (d) 0.5-4 wt% of a polyoxyalkylene-modified organopolysiloxane, as illustrated by the test results shown in Table 3, it is possible to obtain a sunscreen cosmetic that has a long lasting coverage effect and excellent ease of washability, and thus they arrived at the present invention. In contrast, as illustrated in Table 3, Comparative Example 1, which does not include the claimed caprylylmethicone, had a noticeably lower ease of washability (see Specification, page 41, line 7, to page 42, line 2).

[Table 3]

	Example 1	Example 2	Comparative example 1	Comparative example 2	Comparative example 3
(e) Ion-exchange water	30.2	—	30.2	30.2	20.2
1,3-butylene glycol	5	—	5	5	5
(b) Octamethylcyclotetrasiloxane	28	47.5	28	28	28
(c) Caprylylmethicone	5	15	—	5	—
Dimethyl silicone (6cs)	—	—	5	—	5
(d) Branched polyether-modified silicone (Shin-Etsu Chemical Co., Ltd. KF-6028)	1	—	1	1	1
(d) Polyether-modified silicone (Shin-Etsu Chemical Co., Ltd. KF-6017)	—	—	—	—	—
(a) Hydrophobic zinc oxide powder (Manufacturing Ex. 1)	18	25	—	—	—
5% methyl hydrogen-treated zinc oxide (FINEX-50 made by Sakai Chemical Industry Co., Ltd.)	—	—	18	18	18
Spherical PMMA (Microsphere M306)	5	5	5	5	5
Octylmethoxy cinnamate	7.5	7.5	7.5	7.5	7.5
Edetate	0.1	—	0.1	0.1	0.1
Phenoxy ethanol	0.2	—	0.2	0.2	0.2
Long lasting coverage (water-repelling and oil-repelling characteristics)	◎	○	○	○	○
Ease of washability	◎	○	×	△	△

In summary, in view of the disqualification of the Nakamura, et al. reference, the Examiner's claimed combination of references fail to disclose or suggest the organic modified claim material herein. Further, it is strongly urged that none of the cited references herein disclose or suggest the combination of references now claimed in amended base claim 1, in the ratios now claimed herein. Moreover, the cited references, either alone or in combination, fail to provide the unexpected results provided by the now claimed water-in-oil emulsified sunscreen cosmetic of the present invention, i.e., long lasting coverage effect and excellent ease of washability, as illustrated by the comparative test data shown in the Specification. In view of same, it is believed that the

Examiner would be justified in no longer maintaining the rejection. Withdrawal of the rejection is accordingly respectfully requested.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. In the event there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

Donald E. Townsend, Jr.

Donald E. Townsend, Jr.
Reg. No. 43,198

CUSTOMER NO. 27955

Date: March 29, 2011

TOWNSEND & BANTA
c/o PortfolioIP
P.O. Box 52050
Minneapolis, MN 55402
(202) 220-3124